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SUPREME COURT, U.S.

No. 07-315

IN THE

Supreme Court of the United States

PODS, INC.,

Petitioner,

v.

PORTA STOR, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

I. Whether petitioner has presented compelling reasons to grant the Petition, where the United States Court of Appeals for the Federal Circuit ("Federal Circuit") engaged in claims construction of a patent matter, deciding that prosecution history, with its attendant estoppel, limited both the literal infringement available, with the same definitions limiting the equivalents available to the patentees.

II. Whether petitioner has presented compelling reasons to grant the Petition, where the Federal Circuit has not issued conflicting opinions on the issue of the determination of the applicability of prosecution history and the finding of reliance of the patent examiner upon statements made by the patentee during patent prosecution.

STATEMENT PURSUANT TO RULE 29.6

Respondent, Porta Stor, Inc., has no parent corporation and no publicly held company owns 10% or more of its stock.

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Statute

35 U.S.C. 103 17

Question 1. Can the United States Court of Appeals for the Federal Circuit ("Federal Circuit") *sua sponte* raise and decide the issue of prosecution history estoppel on appeal, where that issue was neither raised at trial nor appealed to it?

PODS contends that the Federal Circuit erred in that (1) it decided *sua sponte*, the issue of prosecution history estoppel in Porta Stor's favor, even though that issue had (a) never been raised or addressed at trial, and (b) never been appealed to this Court and (2) the Panel departed from this Court's well-settled precedent in finding prosecution history estoppel based on prosecution statements that did not evince a clear and unmistakable surrender of subject matter.

Appellate Courts Do Not Hear Arguments Never Raised Before

In the Federal Circuit Court of Appeals PODS relied on *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1426 (Fed.Cir.1997) to argue that issues not raised in the lower court should not be raised first on appeal. Porta Stor agrees that this is a state of appellate law, however, that is as far as Porta Stor goes in its agreement with PODS' arguments.

To argue that the "prosecution history" or "prosecution history estoppel" was not raised in the lower court is to ignore a record containing numerous references and arguments directed to the issue of prosecution history estoppel. Moreover, prosecution history examination is an integral component of any claims construction, a function which the District Court

had to carry out in order to construe the claims of the patent. One only has to look as far as *Festo Co. v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd.*, 535 U.S. 722 (2002) to see the intimate relationship between claims construction and the prosecution history. The Southwall Court stated, "prosecution history estoppel limits the range of equivalents available to a patentee by preventing recapture of subject matter surrendered during prosecution of the patent. *Townsend Eng'g Co. v. HiTec Co.*, 829 F.2d 1086, 1090, 4 USPQ2d 1136, 1139 (Fed.Cir.1987)" *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 150, CAFC 1995.

The Vitronics Court underscored how necessary it was to consider the prosecution history, and the resultant prosecution history estoppel, if found. "It is well-settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history. (See *Markman*, 52 F.3d at 979, 34 USPQ2d at 1329). Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language". *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1582 (1996).

Pods first question implies that claims construction may be devoid of any reference to the prosecution history, and, in fact, must be devoid of any inspection of the prosecution history, by the Court, absent an allegation or pleading requesting the Court to so consider the facts. Porta Stor submits that the question has already been long answered, in that the Courts rely on the prosecution history to determine the meaning of

the Claims language, and the any arising estoppel does not come from the pleadings, but from the very words of the prosecution history.

Pods first argument is that the issue of prosecution history estoppel was decided sua sponte by the Federal Circuit Panel, and that the issue of prosecution history estoppel was never raised in the District Court. PODS states, "[t]he bottom line is the Porta Stor indisputably did not raise the issue of prosecution history estoppel at trial or on appeal to the Federal Circuit. Accordingly, PODS had no opportunity at trial or on appeal to make the arguments and present testimony against the applicability of prosecution history estoppel" (Pods' Petition, page 7). Such position requires the truncation of the pre-trial procedures and the trial itself. The arguments and issues regarding the application of the prosecution history and the resultant estoppel occurred before the trial, before the District Court issued its Claims Construction Order. To address PODS' contrived issue is to agree that there is a clear line of demarcation between the Claims Construction and the issues presented before trial. The issue of prosecution history estoppel was presented to the Court during the pre-trial claims construction. Simply put, the issues of prosecution history and estoppel were decided before trial, with the resultant Court's Claims Construction Order being applied at trial. The order, in turn, was the very basis of the Court's directing a verdict for PODS. Porta Stor appealed the District Court's Claims Construction Order.

PODS also states, " [i]n fact, at oral argument before the Federal Circuit, counsel for Porta Stor expressly conceded that he had not raised prosecution history

estoppel as a defense to infringement on appeal". Porta does not agree with PODS' statement. A review of the Federal Circuit recording available at the Federal Circuit web site indicates that the question posed to counsel for Porta Stor was whether Porta raised prosecution history estoppel as it related to the doctrine of equivalents. Porta agreed that it had not, but, Porta Stor did raise the issue as it related to claims construction Porta Stor had raised, and argued, that the statements made during the prosecution limited the claims interpretation to a four sided construct, and could not include a three sided construct. Porta also raised, and argued, that the word "around" was defined to mean on all sides of, and therefore limited claims construction to a device that went around, or on all four sides of, a container. Those are the arguments and issues that were presented to the District Court and the Federal Circuit. Contrary to PODS' statement to this Court, the issue was raised regarding the claims construction and infringement of the patent at issue. PODS had not alleged or offered expert report or testimony as to infringement under the doctrine of equivalents as to Claim 29.

At the center of the issue that serves as the basis for PODS' petition is the question whether a Court, in taking up the matter of Claims construction, can consider the prosecution history, absent a pleading or allegation requesting it to do so, or putting the prosecution history at issue. PODS overlooks the inextricable relationship between claims construction and the prosecution history. The relationship being such that the prosecution history may give rise to a presumption of surrender of the scope

of a claim. In Festo, the Court underscored the relationship of claims construction with the prosecution history.

> Similarly, the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question. As the author of the claim language, his decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim. (citing *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136-137)

Festo, at 725.

Even if the every reference to prosecution history and prosecution history estoppel, which appears in the entire record from the lower court, were to be set aside, the function of claims construction, which is carried out de novo by the Appellate Court necessarily includes prosecution history review and, if amendment or argument is made, an analysis of those amendments or arguments so as to determine if, and to what extent, prosecution history estoppel applies. One only has to go as far as the Zenith case, cited by PODS, to see that claims construction and prosecution history are inextricably intertwined. "Prosecution history serves as a limit on the scope of claims by excluding any interpretation of the claim language that would permit the patentee to assert a meaning from the claim that was disclaimed or disavowed during prosecution in order to obtain claim allowance". *Zenith Laboratories, Inc. v.*

Bristol-Meyers Squibb Co., 19 F.3d 1418, 1421 (Fed.Cir. 1994).

Additionally, and more significantly, is PODS own claims construction statement. The joint claims construction statement, that was presented to the District Court, was partially crafted by PODS counsel and partially crafted by Porta Stor's counsel. PODS recognized, under *Vitronics Corp, v. Conceptronic, Inc.*, 90 F.3d 1576 (1996), the fact of claims construction requiring the court to look into intrinsic evidence...the claims, the specification, and, if in evidence, the prosecution history. PODS repeatedly referenced the prosecution history.

Moreover, in the District Court's order, provided in PODS' petition at pages 25a-34a, the Court directly references (Petition, page 28a) the prosecution history, stating, ". . . Porta takes claim 1's four-sided carrier frame and superimposes it on claim 29 reasoning the '062's **prosecution history and specification demand this interpretation.** Moreover, Porta asserts claim 29's inclusion of the term, "around," adds to this four-sided conclusion" (Bold mine). Magistrate Judge Pizzo of the Florida Middle District Court then stated, "With this same perspective, a court tasked with resolving a claim construction dispute studies the claims and specification, the patent's prosecution history, and, if necessary, consults with outside relevant sources" (Petition, page 29a). The District Court relied on *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed.Cir. 2005) (en banc) and *Festo*, at 733-37, "(prosecution history estoppel requires that the claims of a patent be interpreted by reference to those that have been cancelled or rejected during the

proceedings before the PTO)" (Petition, page 30a). The District Court found, "Much of Porta's argument for a four-sided frame rests on its reading of the '062's prosecution history. . . Porta seizes on patentee counsel's response to the examiner to make its estoppel argument . . ." (Petition, page 31a)

It is confounding how PODS can assert that the issues of prosecution history and prosecution history estoppel were not properly before the Court and not properly raised on appeal as part of the appeal of the District Court's claims construction.

PODS contends that it was unable to present testimony regarding prosecution history estoppel. PODS cites to *Bayer AG v. Elan Pharm. Res. Corp*, 212 F.3d 1241, 1254 (Fed.Cir 2000) for the proposition that "("testimony as to what a reasonable competitor would conclude from the prosecution history . . . is . . . a tool, which the judge can use at his or her discretion, to aid in the legal determination of prosecution history estoppel". PODS misstates the context of the language of the Bayer Court. The Bayer Court carefully explained that prosecution history estoppel is a "purely legal issue" and was important to promote "both uniformity and certainly in the meaning of a patent's claims" *Id.* In the passage cited by PODS, the Court explains that the any testimony regarding what an expert would say as to what a competitor would reasonably view as the metes and bounds of a patent, has minimal value, and may be used as a tool, should the court chose to do so. Such testimony is the equivalent of expert testimony at a Markman hearing, not necessary, and usually marginally helpful. The importance of this interpretation is that such

testimony is unnecessary, and even if it would be helpful, is not a harmful error to not allow such testimony. Claims construction, along with the determination of prosecution history and any attendant estoppel, is strictly a matter of law. Courts rarely need any assistance in determining matters of law.

The issue of claims construction, which necessarily includes an examination of the prosecution history, was raised in the appeal to the Federal Circuit. The issues covered were claims construction, amendment and estoppel, prosecution history, prosecution history estoppel, and means plus function language.

Also standing as direct evidence against PODS new-found assertion, that prosecution history was never brought up before the lower court, are several documents in the record. First PODS refers to prosecution history in its motion for temporary injunction, where PODS expert opines, "with no basis for any estoppel of any claim element of claim, and no limitation of the breadth of this claim . . .". From the very beginning PODS was, to say the least, fully aware of prosecution history and the effects of amendments to the breadth and scope of the claims, vis a vis, estoppel. In Porta Stor's second motion to lift the preliminary injunction, Defendant specifically focused the District Court's attention on Dr. Swanger's opinion and the surrender of coverage brought about by the patentees' amendment.

PODS asserted position that the issue of prosecution history estoppel had never been raised in the lower court flies in the face of the documents of this case, that spell out clearly, and in plain language, that prosecution

history estoppel has been, and is, a large and significant part of the dispute between the parties from the very first hearings in the case.

In fact, the Plaintiff urged the District Court to issue an ex-parte temporary injunction because "no significant amendments had been made". Such an assertion at the very outset of the case can only be made if the Plaintiff made a conscious determination of the amendments and the significance of the amendments. From day one the Plaintiff was aware of the effect of prosecution history and the estoppel that arises, and PODS knew the prosecution history was at issue. PODS assertions that the issue of prosecution history and prosecution history estoppel is a new, heretofore un-raised issue, is contradicted by an abundance of evidence within the documents that had been placed before the Federal Circuit Panel.

Prosecution history was specifically referred to by the Court during the "informal claims construction hearing" where counsel for PODS discussed prosecution history estoppel. The issue of prosecution history was even separately briefed before the trial. A phrase search of the May 2006 Brief to the Court mentioned "prosecution history" eight times in thirteen pages of text. In that document Porta Stor stated, "The issue of applicable estoppel and the effect such estoppel would have on claims construction has been briefed in the past, in particular a brief was submitted as Doc. 113, filed on January 12, 2006". The argument that somehow the Plaintiff is taken by surprise by the Federal Circuit Court of Appeals referring to prosecution history in rendering its decision, is without merit.

Question 2. If prosecution history estoppel is to be based solely on arguments made during prosecution, must the circumstances permit the inference that the examiner relied on those argument in allowing the patent to issue? This Court has yet to rule on that issue and the Federal Circuit has issued conflicting opinions on the issue. Compare *Zenith Labs., Inc. v. Bristol-Meyers Squibb Co.*, 19 F.3d 1418, 1425 n.8 (Fed.Cir.1994) (declining to find prosecution history estoppel because there was "no indication the examiner ever relied on the statements [at issue]. . . in allowing the patent to issue.) with *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 14470 (Fed.Cir. 1995) ("clear assertions made during prosecution in support of patentability, whether or not actually required to secure allowance of the claim may also create an estoppel.")".

In the second question, PODS asserts that the Federal Circuit has issued two conflicting opinions regarding the inference of an examiner relying on arguments made by patentee in allowing the application to pass forward to issue. PODS states the question, "If prosecution history estoppel is to be based solely on arguments made during prosecution, must the circumstances permit the inference that the examiner relied on those argument in allow in the patent to issue?"

PODS offers two cases, *Zenith Labs, Inc v. Bristol-Meyers Squibb Co.*, 19 F.3d 1418, 1425 n. 8 (Fed.Cir. 1994) "declining to find prosecution history estoppel because there was "no indication the examiner ever relied on the statements [at issue]. . . in allowing the patent to issue", and *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570 (Fed.Cir. 1995) "clear assertions made during

prosecution in support of patentability, whether or not actually required to secure allowance of the claim, may also create an estoppel" (Petition, page i)

A reading of both the Zenith and Southwall cases leaves one to ponder where that issue identified by PODS is even raised in the Southwall case.

Zenith is a pharmaceutical case, involving the issue of the crystalline conversion in vivo. The language of Foot note 8 is much like the very question posed by PODS with some important differences. The Zenith Court stated, " if an estoppel is to rest upon argument made during the examination process, the circumstances must be such as to permit the inference that such reliance in fact occurred". In other words, if the Court finds estoppel, the facts of the prosecution history should indicate or infer, that the examiner relied on the statements made in the prosecution history (as is the case in argument based estoppel requiring a clear and convincing surrender of patent territory). PODS provides the word "solely", which does not appear in the Zenith Court's foot note 8. The Zenith Court does not discuss whether the consideration was based "solely" on arguments made. It is apparent that the Zenith Court answered the question, in plain and simple terms. The difference is that the Zenith Court found that if an estoppel is to rest upon argument made during the examination process, the circumstances [of the prosecution history, amendments and arguments] must be such as to permit the inference that the examiner relied on the arguments made during the patent

prosecution. In explaining its position, the Zenith Court stated in FN 8;

> "[a]lthough actual reliance by the examiner need not be shown, if an estoppel is to rest upon argument made during the examination process, the circumstances must be such as to permit the inference that such reliance in fact occurred. A showing that the conduct in question played a material role in the issuance of the patent usually suffices. See *Mannesmann Demag Corp. v. Engineered Metal Prod.*, 793 F.2d 1279, 1285, 230 USPQ 45, 48 (Fed.Cir.1986)".
>
> FN8, *Zenith*, at 1425.

A word search of Zenith gives only one appearance of the word "inference", in footnote 8. The word "infer" is not found using a computer word search.

In Zenith the discussion as to the examiner's state of mind, and what statements the examiner then relied upon, was centered on what the examiner stated as his rationale;

> "[y]et, these prior forms of cefadroxil were never asserted as prior art by the examiner, and the examiner expressly indicated that Bristol's assertions were not a factor in determining patentability. Moreover, according to the examiner's statement of reasons for allowance, the sole basis upon which allowance was challenged, and upon

> which the '657 patent was eventually issued, was related to a single prior art reference, Garbrecht, U.S. Patent No. 3,781,282,FN7 and Bristol's successful showing that the claimed compound was not inherent in that reference". *Zenith*, at 1425.

The "issue" of the "circumstance permitting any inference that the examiner relied on the arguments [of the prosecution history] " just is not present in Zenith.

Southwall is a case concerning the language of the claims and the statements made during prosecution. Southwall initially was determined during Summary Judgment, in which, following PODS' logic, Cardinal IG "never raised the issue of prosecution history at trial". Regardless, the District Court found in favor of Cardinal by way of Summary Judgment.

The word "examiner" appears eight times in Southwall. Each location was identified and read. No where is any question raised that regards any inference that the examiner relied on prosecution history arguments to allow the patent to issue. It had been stated that the examiner rejected the amended claims, but agreed to let them issue following more amendment. But the question generated by PODS, concerning this "issue" can not be found within the four corners of Southwall. A word search of the words, "inference" and "infer" do not generate any "hits" within Southwall. If there is any conflict between Southwall and Zenith, it does not arise concerning any "inference".

Contrary to the "conflict" which PODS reads into the Southwall and Zenith cases, both are consistent with the long standing manner in which claims construction is carried out by the Courts. Southwall examined the prosecution history in the context of claims construction. The Southwall Court applied the specification and the prosecution history to determine what the claims language meant. The Southwall Court reasoned that Claims construction and prosecution history and resultant estoppel must be read in context, and not standing alone as single arguments. Southwall lacks any discussion regarding whether the examiner relied on the arguments made by Southwall in allowing the patent to issue. The Court simply found that arguments made during the Southwall prosecution acted to limit the definition of the terms of the claims. The only allusion to the examiner regarding the claims is that the examiner rejected one of Southwall's claimed equivalents. *Southwall*, at 1579. The Southwall Court provides no discussion concerning any "inference that the examiner relied on the arguments". The Southwall Court found that the prosecution history arguments had limited the equivalents available. *Southwall*, at 1581.

STATEMENT OF THE CASE

Porta Stor would add some facts to those presented by PODS. First, the hearing for preliminary injuction was heard on October 5, 2004 with the decision not being provided until November 2004. Porta Stor moved to have the injuction lifted, and was denied. The Court agreed to re-visit the request to lift the injunction after the parties had arbitrated the issues which took about five months to achieve.

Before trial the District Court issued its claims construction order, which formed the basis for the appeal to the Federal Circuit Court of Appeals.

ARGUMENTS AGAINST GRANTING PETITION

PODS asserts that prosecution history estoppel was never raised before being applied by the Federal Circuit. A review of the Federal Circuit hearing record (Fed.Cir. web site) demonstrates that prosecution history was raised in the context of claim construction and infringement (direct). Argued was that the language of the claims was limited by the statements made by the patentees during the prosecution of the patent at issue. Porta Stor argued that the prosecution history limited the scope of the claims. In turn, the limitation of the language of the claims by prosecution statements affects the issue of both direct infringement and infringement under the doctrine of equivalents by virtue of the fact that the determination of the meaning of words for deciding literal infringement also applies to define the words as they are applied in an equivalents analysis. In determining the claims language, the Federal Circuit also determined whether equivalents were available, and if so, what the equivalents could be, because of the language that affected the claims interpretation for one, affects and controls the claims interpretation of the other.

To reiterate, and again address PODS' assertion that prosecution history was "conceded" not to have been raise as a defense to infringement on appeal, Porta Stor disagrees. A review of the audio record of the hearing before the Federal Circuit indicates that it was conceded by Porta Stor that prosecution history was not raised in

the context of the doctrine of equivalents (meaning only concerning the doctrine of equivalents), but had been raised in the context of infringement and claims construction. The issue, however, contrary to PODS' assertion, was raised.

PODS asserts that prosecution history is different than prosecution history estoppel. The difference between the two concepts has been described by the Spectrum Court in *Spectrum Int'l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1378 n.2 (Fed. Cir. 1998). Prosecution history determines what the words of a claim mean, and prosecution history estoppel determines if the words, can be interpreted to include an equivalent device. Simply put, estoppel does not arise within the context of literal infringement because an element either is, or it isn't. However, missing from any quotation or cite offered by PODS is the holding that prosecution history cannot be applied in determining any equivalent structures.

At bottom, the issue before the Federal Circuit was the question of claims construction, and the claims construction order. The words of the claims were interpreted in light of the prosecution history. The words were given definitions, so that "around" meant on all sides, and a carrier frame was defined as having four sides and encircling a container. There was no argument as to an equivalent of "around". The doctrine of equivalents did not apply, nor could it, because of the strict limitation imposed on the word by the patentees themselves. It was determined, as well as conceded, that Porta Stor's device did not go on all four sides of a container. Hence, the use of the prosecution history

determined that the word "around" meant on all four sides. That element not being satisfied, any other argument was moot, and the claim was not infringed, either Claim 1, 29 or 32, as all contain the word "around".

As the Southwall Court stated, "once an argument is made regarding a claim term so as to create an estoppel, the estopple will apply to that term in other claims". *Southwall,* at 1584. The estoppel, which is preventing a party from a right because of its own actions, is created at the moment of the argument during the prosecution history. PODS would have the Court rule that a Court may interpret the claims based on the prosecution history, but the Court would have to ignore the very terms it had decided unless specific allegations were made. Such a ruling would require a Court to construe the claims, and then not apply the definitions. Such would be an impossible situation. Moreover, the Federal Circuit found that PODS' patentee's statements barred it from asserting Porta Stor infringed Claim 1 (or Claim 32) under the doctrine of equivalents, so any specific raising of estoppel in the context of the doctrine of equivalents was, and is, moot.

Pods argues that there is conflicting precedent regarding argument based estoppel. Note should be taken that this case also involves amendment based estoppel, and amendments to overcome rejection under 35 U.S.C. 103 "obviousness". While both estoppels can exist, as they do in this case, PODS argues the one with the higher standard of proof. That is not to say that both are not present. Should the Petition be granted, Respondent will argue that both, argument based

estoppel and amendment based estoppel, are applicable here.

Use of the Term "Rectangular"

In attempting to find inconsistency where none exists, PODS cites to the Zenith and Southwall cases. PODS then argues, at page 10, "**the examiner himself had already described the frame as rectangular" and *rejected* the claim**". (bold and underline in original). PODS ignores the facts that are pertinent.

In this case the examiner pointed out to the patentees that the prior art did not teach a singular rectangular frame (Dousset had a pair of rectangular frames). The patentee did not "parrot" the language, rather they adopted the language and explained the differences over the prior art using the Examiner's language. And the patentees went further. They both argued that their device went around the container (Doussett was on two sides of a container) and the patentees amended Claim 1 to include the language "around the container" to describe the orientation of the carrier frame and a container. The patentees argued that their device had a single rectangular frame and was capable of going over and around a container located on the ground. The limitation of going "around a container" was added into Claim 1. Such language was offered by the patentee and did not arise from any "parroting". PODS conveniently ignores the record that shows that the patentees differentiated their device from the prior art by amending the claim to include the limitation of "around the container", and in an effort to find an issue that does not exist.

Prosecution History v. Prosecution History Estoppel

PODS argues that "Any argument that PODS had an opportunity to address the issue of prosecution history estoppel through its claim construction arguments would be without merit". PODS cites the Spectrum case, quoting foot note 2, page 1378, stating "this Court has emphasized the 'clear distinction between following the statement in the prosecution history in defining a claim term, and the doctrine of prosecution history estoppel, which limits expansion of the protection under the doctrine of equivalents when a claim has been distinguished over relevant prior art. "*Spectrum Int'l Inc., v. Sterilite Corp.*, 164 F.3d 1372, 1378 n.2 (Fed.Cir.1998). PODS interpretation of the Spectrum language and reliance thereupon is misplaced. The Spectrum Court was explaining that when a court considers the file wrapper it interprets the claim terms in light of the prosecution history (the statements in the prosecution history), as compared to the arguments or amendments made during the prosecution history of the application which affect the scope of the claims and the equivalents available. Where the former defines what the words mean, the latter defines any limitations on the equivalents available within the context of the claims language interpretation.

PODS treats prosecution history estoppel as if it is a separate entity, devoid of any connection with claims construction and the interpretation of what the claims language means. Estoppel arises from the prosecution history, and is part of the prosecution history. Estoppel is the result of the prosecution, and not a separate entity. Common sense would dictate that prosecution history

estoppel cannot exist absent a prosecution history. Porta Stor submits that one cannot reasonably separate the two concepts.

CONCLUSION

PODS arguments that it did not have the opportunity to argue prosecution history, and attendant estoppel, ignores the abundance of court records and documents which plainly and unequivocally set forth prosecution history and prosecution history estoppel as an issue in this matter. PODS position requiring the separation of prosecution history analysis from that of claim construction is unsupported in case law. PODS complaint that it was prejudiced by not having an expert testify as to what a reasonable competitor would understand from the patent language invades the Court's domain as finder of law, in that claims construction, with attendant estoppel analysis, is an issue of law. Lastly, PODS assertion that there is an inconsistency between Zenith and Southwall is not supported by the language of either case. Porta Stor submits that there is no inconsistency, and PODS complaints should be given no further consideration. Porta Stor submits that PODS did not present a convincing argument in support of its Petition for a Writ of Certiorari, and so Porta Stor requests that the United States Supreme Court deny PODS' Petition.

Respectfully submitted,

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